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09/304,204	05/03/1999	ADRIAN GROPPER	915780/002	9355

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PATENT ADMINISTRATOR
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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/22/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/304,204

Applicant(s)

GROPPER ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6,8-10,12-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-34 is/are allowed.
- 6) ☒ Claim(s) 12 and 15-25 is/are rejected.
- 7) ☒ Claim(s) 3-6,8-10,13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed on 9/19/03 to the application filed 5/3/99.
2. Claims 1-2, 7, 11, 26, 35-37 are canceled.
3. Claims 3-6, 8-10, 12-25, 27-34 are pending in the case. Claims 3, 12, 19, 27 are independent claims.
4. The rejections of claims 35-37 under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter have been withdrawn in view of the cancellation of claims 35-37.
5. The rejections of claims 1 and 12 under 35 U.S.C. 102(a) as being anticipated by Kraft, IV have been withdrawn in view of the cancellation of claim 1 and the amendment of claim 12.
6. The rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV have been withdrawn in view of the cancellation of claim 2.
7. The rejection of claims 7 and 11 under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV and further in view of Nielsen have been withdrawn in view of the cancellation of claims 7 and 11.
8. The rejection of claim 26 under 35 U.S.C. 103(a) as being unpatentable over Campbell have been withdrawn in view of the cancellation of claim 26.

Claim Objections

9. Independent claim 3 is objected to because it includes the numbers 1, 2, and 3 within the claimed limitations.

It is suggested to use the alphabet (e.g. a, b, c...) within the parentheses so as to avoid confusion with the claim number as well as with other characters which may appear in the claims or to amend the claim without the need of including the numbers.

Dependent claims 4-6, 8-10 are objected to for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV (US Pat No. 5,870,767, 2/9/99, filed 11/22/96) in view of Cassorla et al. (US Pat No. 5,146,552, 9/8/92, filed 2/28/90).

Regarding independent claim 12, Kraft discloses:

- creating the text for a document (figure 8, #138-#140, the hypertext document selection by the graphical user interface inherently shows that the text document is created; col 7, line 64 to col 8, lines 1-4)
- retrieving link information to be displayed along with the text in association with a predetermined portion of the text (figure 6, #124; figure 7, #130, #134; figure 8, #142)
- creating an independent endnote containing information sufficient to link said predetermined text portion and link information (figure 8, #144, generate footnote, #146, associate footnote with hyperlink address which is included in the text portion)

Though Kraft does not explicitly mention a report, the hypertext document in Kraft inherently includes a report since a report is merely a form of document.

Kraft does not disclose attaching the endnote to the document after the text without adding or deleting a character in the text section.

Cassorla discloses:

- creating an independent endnote containing information linking said predetermined text portion and link information (abstract; figures 5-6; col 2, lines 5-55)
- attaching the endnotes to the document without adding or deleting a character in the text (abstract and col 2, lines 5-55: "annotations stored separately from the originally published document are associated by name with the document... the attachment of annotations is a capability provided to the reader of an electronic document and does not require any specific preparation on the part of the writer or editor of an electronic document."; the fact that the attachment of the annotation notes to the published document without requiring any specific preparation on the part of the writer or editor indicates that when attaching the annotation notes to the document, the text in the electronic document is not modified by the writer or editor, that means no character is added to or deleted from the text)

Cassorla does not disclose that the endnotes are attached to the document after the text. However, since annotation notes can be *attached to the document at desired position defined by a user* (col 2, lines 41-45), it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Cassorla to attach the annotation notes after the text of the document as an endnote as desired. Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cassorla into Kraft since Cassorla teaches

Art Unit: 2178

attaching the annotation notes to the published document without adding or deleting a character in the text document providing the advantage to eliminate the modify step on the text when attaching the endnote to the section in Kraft, and also to maintain the integrity of the text when the attach process is performed.

13. Claims 16 and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft, IV (US Pat No. 5,870,767, 2/9/99, filed 11/22/96).

Regarding claim 16, which are dependent on claim 12, Kraft does not disclose that said link information includes an image. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft to include an image into the link information since it was well known in the art that a hyperlink can be in text or image form.

Regarding independent claim 19, Kraft discloses:

- opening and displaying the text at a terminal (figure 8, #138, #140)
- activating the link (figure 6, #124, col 7, lines 40-49, IBM link is activated by user clicking; figure 8)
- identifying the appropriate endnote corresponding to the activated link (figure 7, the endnote include the activated link)

Kraft does not disclose retrieving link information at an address in accordance with information included in the endnote and displaying said retrieved link information.

Instead Kraft discloses that from the graphical interface includes, a user can select a command from a pull down menu for viewing or printing a selected data (col 6, lines 24-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft to include retrieving link information at an address in accordance with information included in the endnote and displaying said retrieved link information since a user can select the link information in accordance with the information included in the endnote for displaying instead of selecting other data for displaying from the menu.

14. Claims 15, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Cassorla as applied to claim 12 above, and further in view of Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Regarding claim 15, which is dependent on claim 12, Kraft and Cassorla do not disclose that the endnote includes text modification *instructions for modifying the display* of the predetermined portion of the text to indicate that characters contained in the predetermined portions are linked.

Nielsen discloses that the endnote includes *an instruction for viewing a note* which is in a predetermined portion of the text to indicate that the character contained in the predetermined portions are linked (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the instruction of Nielsen "See note #2" to include text modification instructions for modifying the display of the predetermined portion of the text to indicate that characters contained in the predetermined portions are linked since it is possible to replace another instruction in the endnote.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft and Cassorla to enhance the endnote creation in Kraft and Cassorla where the content of the endnote may include both the link information or any instruction related to the text document.

Regarding claims 17 and 18, which are dependent on claims 12 and 17 respectively, Kraft and Cassorla do not disclose providing an end of text marker after the text and attaching the endnote to the report after the end of the text marker wherein the end of text marker is a signature.

Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include a signature as an end marker of the text section since a signature is merely a short text as a note.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft and Cassorla to easily

differentiate each separate section in a document by a signature as end marker to mark at the end of each section.

15. Claims 20-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft as applied to claim 19 above, and further in view of Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Regarding claim 20, which is dependent on claim 19, Kraft does not disclose that the endnote includes text modification *instructions for modifying the display* of the text to be linked and modifying the display of the text in accordance with the instructions.

Nielsen discloses that the endnote includes *an instruction for viewing a note* which is in the display of the text to indicate the portion of the text to be link (figures 9B-C, the endnote includes the instruction "See note #2").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the instruction of Nielsen "See note #2" to include text modification instructions for modifying the display of the text to indicate the portion of the text to be linked since one can replace one instruction by another instruction.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft to enhance the endnote content to include a modifying instruction for modifying the selected text in accordance with the instructions in addition to displaying and printing instructions.

Regarding claim 21, which is dependent on claim 19, Kraft and Nielsen do not disclose retrieving the link information from a repository.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Kraft and Nielsen to include retrieving the link information from a repository since it was well known in the art that all the information data is stored in a database, which is a repository, for retrieving data later on.

Regarding claim 22, which is dependent on claim 19, Kraft discloses that the link information is a web site (figure 7, #130).

Regarding claim 23, which is dependent on claim 19, Kraft does not disclose providing an end marker at the end of the text section and reading the text portion line by line into a temporary memory as text until the signature is read, and operating on the endnote operation so that each line of text is processed as a separate data structure.

Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to provide a signature as an end marker of the text section since a signature is merely a short text as a note to indicate the end of a section.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include "reading the text portion line by

line...until the signature is read” and “operating on the endnote....”since for storing a document with an end marker at the end of the text section and the attached endnote, the system has to read the document character by character until the signature, which is the end of the text section, to store the text section data in the memory, and then read the text on the endnote as a separate data structure. Since each line includes a number of characters, reading characters in the lines is considered as reading line by line. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft since Nielsen suggests a signature as an end marker of the text section providing the advantage of easily differentiating the different sections between the text section and the endnote section as in Kraft.

Regarding claim 24, which is dependent on claim 23, Kraft does not disclose operating upon each line of text by inserting said line of text into a Java Swing document, and modifying the text in accordance with the instructions stored in the endnote to indicate where links exist.

Instead Kraft discloses the commands in the menu for displaying and printing documents (col 6, lines 24-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the Kraft menu to incorporate the inserting and modifying commands for modifying documents in text section or in the endnote section to enhance menu commands applied on the documents.

Regarding claim 25, which is dependent on claim 19, Kraft does not disclose providing an end marker at the end of the text section and reading the text portion *character by character* into a temporary memory as text until the signature is read, and operating on the endnote operation so that each line of text is processed as a separate data structure.

Nielsen discloses the note "An internal Reference" at the end of the text section (figures 9B-C).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to provide a signature as an end marker of the text section since a signature is merely a short text as a note to indicate the end of a section.

Further, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Nielsen to include "reading the text portion *character by character*...until the signature is read" and "operating on the endnote...."since for storing a document with an end marker at the end of the text section and the attached endnote, the system has to read the document character by character until the signature, which is the end of the text section, to store the text section data in the memory, and then read the text on the endnote as a separate data structure. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Nielsen into Kraft since Nielsen suggests a signature as an end marker of the text section providing the advantage of easily

differentiating the different sections between the text portion and the endnote section as in Kraft.

Allowable Subject Matter

16. Claims 3-6, 8-10 would be allowable if rewritten or amended to overcome the objections, set forth in this Office action.

17. Claims 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. Claims 27-34 are allowed.

19. The following is a statement of reasons for the indication of allowable subject matter: a method for creating a report based upon a protocol where the steps of modifying the endnote to contain data for identifying a patient to which the protocol is to be performed, and increasing the workflow state value stored in the workflow state indicator when modifying the endnote with specific protocol steps to indicate the modification and the performance of the protocol, were not disclosed by, and would not have been obvious over the prior art of record.

Response to Arguments

20. Applicant's arguments with respect to claims 12, 15-8 have been considered but are moot in view of the new ground(s) of rejection.

Regarding independent claim 12, Applicants argue that Kraft does not disclose "attaching the endnote to the report after the text, without adding or deleting characters from the text" since there is a change of the text in figure 6 into figure 7 (Remarks, page 9).

Examiner agrees.

Cassorla, in combination with Kraft, discloses storing separately the published document and the corresponding annotation file or the note file so that when attaching the annotation file to the published document, there is no requirement of preparation from the writer or the editor (col 2, lines 5-55). This shows that the text of the published document is not edited when attaching process is performed. In other words, Cassorla discloses and suggests attaching the endnote to the text document without adding or deleting characters from the text.

Further, since annotation notes can be attached to the document at a desired position defined by a user (col 2, lines 41-45), it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Cassorla to attach the annotation notes after the text as an endnote as desired.

In addition, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cassorla into Kraft since Cassorla teaches attaching the annotation notes to the published document without adding or deleting a character in the text document providing the advantage to eliminate the modify step on the text when attaching the endnote to the text section in Kraft, and also to maintain the integrity of the text when the attach process is performed.

21. Applicant's arguments filed 9/22/03 have been fully considered but they are not persuasive.

Regarding independent claim 19, Applicants argue that Kraft does not disclose "opening and displaying the text at a terminal" and "activating the link" since Kraft teaches printing a document into a printable medium (as in the abstract), and the printed document can not be opened and displayed at a terminal, and links within a printed document can not be activated (Remarks, page 10).

Examiner respectfully disagrees.

It is true that Kraft teaches rendering a printed format for a document. However, the document before to be printed, is opened and displayed at a terminal on the user graphical interface as stated in the abstract: "rendering in a printable medium *hyper-link information contained in a document displayed within a graphical user interface ... a document constructed* from data generated at a data processing network server is selected and *displayed within a graphical user interface* ..."

Kraft further discloses "opening and displaying the text at a terminal" and "activating the link" in figure 8, #138 Graphical user interface selects hypertext document, #140 Graphical user interface *renders hypertext document to the screen for viewing* – shows the open and the display of the text document, #142 Hyperlink addresses in hypertext document? – shows the hyperlink in the text document, and once the hyperlink is in an electronic document, it was well known that the hyperlink can be activated.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PR Newswire, EndNote 3.0 : The First Internet Search Client that Creates
Bibliographies, Feb 25, 1998, pg. 1.

Gibson, Create perfect footnote with ease, Inside Corel WordPerfect Suite, Feb 1999,
Vol. 4, pg. 1, 5 pgs.

Schilit et al. (US Pat No. 6,356,922 B1, 3/12/02, filed 6/19/98).

Walker et al. (US Pat No. 6,449,616 B1, 9/10/02, filed 10/22/99, priority 10/11/96).

Schilit et al. (US Pat No. 6,658,623 B1, 12/2/03, filed 9/15/97).


Robertson et al. (US Pat No. 6,507,410 B1, 1/14/03, filed 9/8/98).

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
12/11/03



STEPHEN S. HONG
PRIMARY EXAMINER